

REMARKS

Claims 12-136 stand finally rejected in the application. With this amendment, Applicants have cancelled Claim 98. Upon entry of the amendment, Claims 12-97 and 99-136 remain pending.

RE-PRESENTATION OF PRIOR AMENDMENTS

Upon review of the application, Applicants discovered that previously presented claims and amendments to these claims may not have been properly presented. Applicants now offer the amended claims in proper format with changes made to-date relative to the patent being reissued shown in underlining for additions, in compliance with 37 CFR 1.173(d)(2). Applicants respectfully request entry of the amendments. Other than cancellation of Claim 98, this amendment makes no substantive revision to the claims as they were intended to be amended in Applicants' Amendments filed October 18, 2005 and August 19, 2003.

OBJECTION TO THE REISSUE APPLICATION

The application is objected to under 37 CFR § 1.172(a). The Final Rejection states that the submission establishing the ownership interest of the Assignee is informal and that there is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the Assignee.

Applicants respectfully submit that the papers earlier filed are in proper order and that it is permissible for the same person (i.e., Chief Executive Officer of the Assignee) to sign both the statement establishing its ownership interest and the consent to the reissue under 37 CFR § 3.73(b). In the interest of advancing prosecution, and as suggested in the Office Action, Applicants enclose herewith a statement signed by Applicants' attorney that the Chief Executive

Officer of BMG is authorized to sign the “Assignee Consent” on behalf of the company. For convenience and reference, a copy of the earlier signed “Assignee Consent under 37 CFR § 1.172” is also attached.

Applicants respectfully request the papers be entered and the objection to the Reissue Application be withdrawn.

REJECTION UNDER 35 U.S.C. § 112

Claims 12-136 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action states the claims fail to specify that a raw UHMWPE is irradiated, then heated to its compression deformation temperature, compression deformed, and then cooled and solidified while keeping the deformed state. Applicants have cancelled Claim 98 as not further limiting Claim 84. As to the other claims, Applicants respectfully traverse the rejection and request reconsideration.

Applicants respectfully submit that support for claims omitting the step of keeping the deformed state while cooling is fully supported by the specification. Attention is respectfully drawn to column 4, lines 37-41, discussing the treatment of the UHMWPE after compression deformation:

“If the deformed state is set free before solidification, the stretched molecular chains are relaxed and stressed to return to the original state because the compression deformation is conducted in the molten state.”

Although the specification continues that in certain embodiments the process of omitting the step (i.e. of setting free the deformed state before solidification) is less preferred, the above passage provides support for the claims omitting that step. That is, the embodiments omitting the step are fully disclosed, notwithstanding that other embodiments including the step are disclosed and are taught as preferred.

On the basis of the above arguments, Applicants respectfully submit that the rejected claims have full support under § 112. Accordingly, Applicants respectfully request the rejection be withdrawn.

REJECTION UNDER 35 U.S.C. §§ 102/103

Claims 12-20, 23-36, 38-39, 45-51, 54-62, 66-76, 79-83, 89-95, 102-110, 116-117, 119-125, and 127 are rejected under 35 U.S.C. § 102(b) as being anticipated or in the alternative as obvious over the Sun et al. reference (U.S. Pat. No. 5,414,049). Applicants respectfully traverse the rejection and request reconsideration.

METHOD CLAIMS

As a preliminary matter, Applicants wish to point out that rejected Claims 45-51, 89-95, 116-117, and 133-135 are method claims that depend, respectively, from non-rejected Claims 40, 84, 111, and 128. Because the other rejected claims are product-by-process claims as discussed on pages 5-10 of the Office Action, Applicants believe the Examiner may have included the above method claims in this art rejection in error. If this is the case, Applicants respectfully request the rejection under §§ 102/103 with respect to Claims 45-51, 89-95, 116-117, and 133-135 be withdrawn.

PRODUCT-BY-PROCESS CLAIMS

Applicants acknowledge that patentability of a product does not depend on its method of production and that product-by-process claims are anticipated by prior art disclosures of the same structure even if made by a different process. But Applicants maintain their position that the current claims recite structures different from those in the art of record.

As noted in the Office Action, the Sun reference does not teach or suggest applying a compression deformation step to a UHMWPE. The step of deformation necessarily changes the structure of the final UHMWPE product. Applicants respectfully submit that comparative physical data, such as the coefficient of friction or wear data suggested by the Examiner at page 3, are not required to show such a difference in light of the understanding of one of skill in the art reading the current specification that the compression deformation step changes the structure of the UHMWPE. For these reasons, the products made by the processes recited in the rejected claims lead to UHMWPE and implants that have different structures than those in the prior art. For these reasons, Applicants respectfully request that the rejections be withdrawn.

ALLOWABLE CLAIMS

Applicants note with appreciation that Claims 40, 84, 111, 128, and dependent Claims 41-44, 52, 53, 85-88, 97-101, 112-115, 118, 129-132, and 136 would be allowable if re-written or amended to overcome the §112 rejections above and/or to set forth all of the limitations of the base claim and any intervening claims. Applicants respectfully submit the §112 rejections have been successfully traversed above and request that the above claims be considered as containing allowable subject matter as written.

CONCLUSION

For the reasons discussed above, Applicants believe that Claims 12-97 and 99-136 are in allowable condition and respectfully request an early Notice of Allowance. In the alternative, the Examiner is respectfully requested to issue an Advisory Action stating whether the amendments can be entered or the remarks considered at this time. The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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